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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,756

Applicant(s)

BANERJEE ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEFFREY D. CARLSON  
PRIMARY EXAMINER



### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-31 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 12/16/04 is sufficient to overcome the Gerace reference.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 8-10, 12, 13, 16-18, 20, 21, 24, 25, 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Fano (6,317,718) and further in view of Hoshi (4,934,079).

Claim 1, 9, 17, 25, 29-31: Gerace discloses a method, system, medium for providing targeted advertising content, comprising:

detecting a change in one or more physical parameter that is representative of a local event associated with a given local environment (col 6, lines 13-21; col 22, lines 22-26; col 21, lines 49-52; col 22, lines 9-11; col 10, lines 51-65; col 8, line 51-col 9, line 7);

selecting an advertisement having a predetermined association with the local event detected (col 8, line 51-col 9, line 7; col 16, lines 42-52); and

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delivering the advertisement to a local communicating device associated with the given local environment (col 16, lines 42-52; Fig. 1).

Gerace further discloses information provided to a user based on changes in a local event or on user location (col 21, lines 40-50; col 22, lines 5-11).

Fano discloses receiving a wide variety of information deemed relevant to a user (col 36, lines 50-60).

Fano further discloses communicating electronically with a sensor placed within a local environment, that the sensor detecting a change in the local environment and communicating the change, wherein the local event is other than an interaction by a consumer with a browser (col 36, line 60-col 37, line 50; col 38, lines 9-12; col 38, line 65-col 39, line 15, note the 'keycard reader' sensor in this citation).

Note that Fano's Magic Wall can be placed publicly (col 36, lines 32-35) that there is more than one Magic Wall (Fig 24).

Also, note that Fano discloses the user utilizing shopping stores, malls (Fig. 27; col 49, lines 23-35), numerous user devices including both mobile and stationary, home user and public user devices (Fig. 17); home use (col 30, lines 50-55; col 35, lines 1-13); room specific information (col 2, lines 15-20).

Also, note that Fano discloses both a Magic Wall that acts as a sensor for detecting changes in a local event (see reference above) as well as a PDA that detects changes in a local event where the change is user position movement and the local environment can be defined as a store or as a mall (col 49, lines 19-35). Also, note that it is obvious to one skilled in the art that

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there are both indoor and outdoor malls. Also, note that it is obvious to one skilled in the art that Fano's Magic Wall can be placed anywhere that a wall (full or partial) can be placed.

Additionally, Hoshi further discloses that the change in local event that initiates the presentation of user relevant information can be input from a sensor on information relating to light, sound, heat, etc (Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Fano's and Hoshi's further information on detecting changes in local events to Gerace's providing relevant information to a user based on changes in local area. One would have been motivated to do this in order to better utilizing user profiling information and better be able to provide relevant information to a user.

Claim 2, 10, 18: Gerace, Fano, and Hoshi disclose the method of claim 1, Gerace further discloses that the local communicating device communicates with a consumer within the given environment by audio performance or video display (col 6, lines 15-21).

Claim 4, 12, 20, 28: Gerace, Fano, and Hoshi disclose the method of claim 1, Gerace further discloses the step of selecting an advertisement comprises searching a database of advertisements and events associated with the advertisements (col 16, lines 42-52; Fig. 2; Fig. 3a).

Claim 5, 13, 21: Gerace, Fano, and Hoshi disclose the method of claim 1, Gerace further discloses that the local communicating device is associated with the given local environment by a factor selected from common location, common owner, or common user (col 10, line 51-col 11, line 11).

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Claim 8, 16, 24: Gerace, Fano, and Hoshi disclose the method of claim 1, Gerace further discloses:

identifying a consumer profile associated with the local communicating device, and selecting an advertisement having a predetermined association with the local event detected and one or more aspect of the consumer profile (col 16, lines 37-55).

Claim 27: Gerace, Fano, and Hoshi disclose the advertisement provider computer of claim 25.

Gerace further discloses that the advertising module is further configured to accept a content provider information, wherein the content provider information comprises content provider demographic information, and wherein the advertisement is selected on the basis of consumer activity and one or more additional criteria selected from the group consisting of consumer demographic information and content provider demographic information (col 19, lines 5-32; Fig. 5a; Fig. 5c).

4. Claims 3, 11, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Fano (6,317,718) in view of Hoshi (4,934,079) and in further view of Ghori (6,243,772).

Claim 3, 11, 19: Gerace, Fano, and Hoshi discloses the method of claim 1.

Gerace further discloses the device can be any device that utilizes a computer or a network (Fig. 1; col 3, lines 38-67).

Gerace further discloses that the device can be a computer (col 6, lines 13-21).

Gerace does not explicitly disclose the other types of devices that can be utilized.

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However, Gerace discloses the utilization of the Internet (col 3, lines 50-55); radio and television (col 36, lines 49-59).

However, Fano discloses the utilization of Internet appliances and PDAs (Fig. 17).

Ghori discloses the utilization of network-connected electronic white goods (col 7, lines 25-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a device that can be connected to a computer or network can be utilized by Gerace's invention. One would have been motivated to do this in order to provide more flexibility through providing more devices that can be utilized with the system.

5. Claims 6, 14, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Fano (6,317,718) in view of Hoshi (4,934,079) and in further view of Wong (6,640,142).

Claim 6, 14, 22: Gerace, Fano, and Hoshi disclose the method of claim 1.

Gerace further discloses that the one or more physical parameter is selected from the group consisting of motion, position (col 10, line 51-col 11, line 12).

Gerace further discloses tracking aspects of user movement and local user environment (col 10, line 51-col 11, line 12; col 16, lines 55-67; col 17, lines 45-52), reporting and recording relevant temperatures (col 8, lines 60-65); user display preferences (col 6, lines 30-35; col 11, lines 24-56).

Gerace further discloses that any available information can be utilized for psychographic, demographic profiling and targeting (col 2, lines 1-35; col 6, lines 58-col 7, line 22).

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Gerace does not explicitly disclose recording voltage, light, volume parameters.

However, Wong discloses a computer connected to a network (Fig. 1; Fig. 2) and tracking and recording user situation parameters such as light, volume, and combinations thereof (col 2, lines 50-61; Fig. 2, item 250).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wong's further situation parameters to Gerace's user display tracking and local environment tracking. One would have been motivated to do this in order to provide further information on user circumstances that can be utilized for psychographic, demographic profiling and targeting.

6. Claims 7, 15, 23, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396).

Claim 7, 15, 23, 26: Gerace discloses the method of claim 1.

Gerace does not explicitly disclose that the identified local event is assigned an event code.

However, Gerace further discloses that the identified local event is identified with a unique event identification (col 16, lines 55-67; col 16, lines 64-67).

Gerace further discloses accepting a consumer event information from the consumer (col 16, lines 50-55; col 9, lines 8-30).

Since the data is entered into respective objects and the data is also analyzed, it would be obvious to one of ordinary skill in the art to utilize codes. One would be motivated to utilize codes in order to assist with the data identification.



### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Young (4,358,754) discloses utilizing local sensor information for providing advertising;
- b. Gershenfeld (5,936,412) discloses utilizing local sensor information for providing advertising (col 3, lines 40-55).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD  
1/11/05

  
JEFFREY D. CARLSON  
PRIMARY EXAMINER